



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,601	10/17/2000	Malik Mamdani		2571

7590 11/24/2004

THOMAS F. BERGERT, ESQUIRE
WILLIAM MULLEN
8270 GREENSBORO DRIVE
SUITE 700
MCLEAN, VA 22102

EXAMINER

HAYES, JOHN W

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/690,601

Applicant(s)

MAMDANI ET AL.

Examiner

John W Hayes

Art Unit

3621

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 24-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 24-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07 October 2004 has been entered.

Status of Claims

2. Applicant has amended claims 1, 21-22, 24, 26, 29, 33, 35-38 in the amendment filed 07 October 2004. Applicant previously canceled claim 23. Thus, claims 1-22 and 24-38 remain pending and are presented for examination.

Response to Arguments

3. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 6, 10-15, 19-20, 22, 24-29 and 33-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferber et al, U.S. Patent Application Publication No. US 2002/0004746 A1.

Art Unit: 3621

As per **Claims 1-4, 11-12 and 37**, Ferber et al disclose a method and system for facilitating a wireless transaction comprising a transaction fulfillment system for:

- communicating a first transaction code to a wireless communication device, said code representative of a previously requested wireless transaction for a product or service, said wireless transaction requested by a transaction requestor (Figures 1 and 4; 0008; 0009; 0010; 0021; 0023; 0028; 0029; 0030);
- optically scanning, by a transaction fulfillment system, the first transaction code from a visual display of the wireless communication device in fulfillment of said wireless transaction for a product or service (0009; 0025; 0030); and
- triggering, by said transaction fulfillment system, a wireless transaction fulfillment event in response to optically scanning said first transaction code (0025; 0030).

As per **Claims 13-14**, Ferber et al further disclose communicating the first transaction code from a radio transceiver of the transaction fulfillment system to a radio transceiver of the wireless communication device (Figures 1 and 4; 0008; 0009; 0010; 0021; 0023; 0028; 0029; 0030).

As per **Claims 6 and 10**, Ferber et al further disclose communicating a decoded representation of the first transaction code from the transaction fulfillment system to a transaction management system (0025; 0030).

As per **Claim 19**, Ferber et al further disclose receiving, by the transaction fulfillment system, a transaction request from the wireless communication device prior to communicating the first transaction code (0028; 0030).

As per **Claims 15 and 20**, Ferber et al further disclose wherein communicating the first transaction code includes communicating a first optically scannable transaction code (Figures 1 and 4; 0008; 0009; 0010; 0021; 0023; 0028; 0029; 0030).

Art Unit: 3621

As per **Claim 22**, Ferber et al disclose a method for facilitating a wireless transaction comprising:

- receiving, by a transaction fulfillment system, a transaction request for a product or service from a transaction requester (0028; 0030);
- communicating a transaction code from the transaction fulfillment system to a wireless communication device, after verifying the identity of the transaction requestor, said code representative of said transaction requested (Figures 1 and 4; 0008; 0009; 0010; 0021; 0023; 0026-0030);
- optically scanning, by the transaction fulfillment system, the transaction code from a visual display of the wireless communication device in fulfillment of said transaction for a product or service (0009; 0025; 0030); and
- triggering, by said transaction fulfillment system, a wireless transaction fulfillment event in response to optically scanning said first transaction code (0025; 0030).

As per **Claims 24-25**, Ferber et al further disclose wherein the transaction fulfillment system is coupled to a telecommunication network system through a computer network system for enabling communication with the wireless communication device (Figure 1).

As per **Claims 26-28 and 36**, Ferber et al further disclose wherein the transaction fulfillment system is coupled to a wireless data network system through a computer network system for enabling communication with the wireless communication device (Figure 1; 0021; 0022).

As per **Claim 29**, Ferber et al further disclose a transaction management system coupled to the transaction fulfillment system and capable of verifying an identity of a transaction requestor (0026-0028).

As per **Claims 33-34**, Ferber et al further disclose a code scanning device such as a bar code reader for optically scanning the transaction code (0009; 0025).

As per **Claim 35**, Ferber et al further disclose decoding the transaction code in response to optically scanning the transaction code (0025; 0030).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferber et al, U.S.

Patent Application Publication No. US 2002/0195495 A1 in view of Pitroda, U.S. Patent No. 5,590,038.

As per **Claims 30-32**, Ferber et al fail to explicitly disclose verifying the identity of the transaction requestor through the use of a speech services module for audibly verifying the identity of the requestor by comparing voice prints. Examiner takes Official Notice that verifying the identity of a transaction requestor is notoriously well known in the business art. For example, Pitroda discloses an electronic transaction system and method for conducting electronic transactions and teaches a method for verifying the identity of a transaction requestor by displaying signatures of use of other types of identification such as photographs, finger prints or voice prints (Col. 12, lines 54-58). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Melick et al and verify the identity of the transaction requestor for obvious reasons such as ensuring that the requestor is actually the person they say they are and are authorized to carry out the transaction.

8. Claims 5, 7-9, 16-18, 21 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferber et al, U.S. Patent Application Publication No. US 2002/0195495.

As per **Claim 5**, Ferber et al fail to explicitly disclose verifying the first transaction code in response to scanning the first transaction code, however, examiner submits that one having ordinary skill in the art at the time of applicant's invention would have recognized that this is a well known step when

Art Unit: 3621

redeeming coupons. For example, at a minimum, an expiration date associated with the coupon code would have been verified.

As per **Claims 7-9, 16-18**, Ferber et al fail to explicitly disclose communicating a first or second fulfillment verification to the transaction management system or communicating a second transaction code to the wireless communication device. Examiner submits that communicating verification messages and multiple transaction codes in a transaction system would have been obvious to one having ordinary skill in the art at the time of applicants claimed invention. It also would have been obvious to one having ordinary skill in the art to communicate multiple transaction codes and multiple verification messages in any transaction system since it has been held that mere duplication of the essential working parts of a device or duplication of steps involves only routine skill in the art. See *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

As per **Claims 21 and 38**, Ferber et al disclose a method and system for facilitating a wireless transaction comprising a transaction fulfillment system for:

- receiving a transaction request from a transaction requestor (0010; 0028; 0029; 0030);
- optically scanning, by a transaction fulfillment system, a transaction code from a visual display of the wireless communication device, said code representative of said requested transaction (0009; 0025; 0030); and
- enabling fulfillment of the transaction request in response to scanning the transaction code, including triggering at least one physical fulfillment event (0025; 0030).

Ferber et al, however, fail to explicitly disclose that the requested transaction is for admission to an event. Examiner takes official notice, however, that coupons were frequently used for admissions to certain events at the time of applicant's invention and it would have been obvious to one of ordinary skill in the art at the time of applicant's invention that the coupon disclosed by Ferber et al may have been used for access to any type of product or service, including admission to an event.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-20, 22 and 24-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/690,212 and further in view of Ferber et al, U.S. Patent Application Publication No. 2002/0004746 A1. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claim 1 of U.S. Patent Application No. 09/690,212 recites:

- communicating a first transaction code to a wireless communication device; and
- optically scanning the first transaction code from the visual display of the wireless communication device

Claim 1 of U.S. Patent Application No. 09/690,212 differs since it further recites additional claim limitations including receiving a transaction request from a transaction requester, verifying an identity of the transaction requester and receiving a decoded representation of the first transaction code. However, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of U.S. Patent Application No. 09/690,212 by removing the limitations directed to these additional steps resulting generally in the claims of the present application since the claims of the present application and the claim recited in U.S. Patent Application No. 09/690,212 actually perform a similar function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

Art Unit: 3621

Claim 1 of U.S. Patent Application No. 09/690,212 further fails to recite that the code is representative of a previously requested wireless transaction for a product or service, said wireless transaction requested by a transaction requester, and triggering a wireless transaction fulfillment event in response to optically scanning said first transaction code. Ferber et al disclose these limitations in connection with requesting a transaction involving a coupon. Ferber also discloses communicating a first transaction code to a wireless communication device, said code representative of a previously requested wireless transaction for a product or service, said wireless transaction requested by a transaction requestor (Figures 1 and 4; 0008; 0009; 0010; 0021; 0023; 0028; 0029; 0030) and triggering, by said transaction fulfillment system, a wireless transaction fulfillment event in response to optically scanning said first transaction code (0025; 0030). Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify claim 1 of U.S. Patent Application No. 09/690,212 and include the limitations as taught by Ferber et al in an effort to carry out or fulfill a transaction previously requested by the requestor.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 21 and 38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/690,212 in view of Ferber et al, U.S. Patent Application Publication No. US 2002/0004746 A1.

Claim 1 of U.S. Patent Application No. 09/690,212 recites:

- receiving a transaction request from a transaction requestor;
- optically scanning a transaction code from a visual display of the wireless communication device

Claim 1 of U.S. Patent Application No. 09/690,212 also differs since it further recites additional claim limitations including receiving a transaction request from a transaction requester, verifying an identity of the transaction requester and receiving a decoded representation of the first transaction code. However, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of U.S. Patent Application No. 09/690,212 by removing the limitations directed to these additional steps resulting

Art Unit: 3621

generally in the claims of the present application since the claims of the present application and the claim recited in U.S. Patent Application No. 09/690,212 actually perform a similar function. It is well settled that ~~the omission of an element and its function is an obvious expedient if the remaining elements perform the~~ same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

Claim 1 of U.S. Patent Application No. 09/690,212 further fails to recite that the code is representative of a previously requested wireless transaction for a product or service such as admission to an event, said wireless transaction requested by a transaction requester, and triggering a wireless transaction fulfillment event in response to optically scanning said first transaction code. Ferber et al disclose these limitations in connection with requesting a transaction involving a coupon. Ferber also discloses communicating a first transaction code to a wireless communication device, said code representative of a previously requested wireless transaction for a product or service, said wireless transaction requested by a transaction requestor (Figures 1 and 4; 0008; 0009; 0010; 0021; 0023; 0028; 0029; 0030) and triggering, by said transaction fulfillment system, a wireless transaction fulfillment event in response to optically scanning said first transaction code (0025; 0030). Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify claim 1 of U.S. Patent Application No. 09/690,212 and include the limitations as taught by Ferber et al in an effort to carry out or fulfill a transaction previously requested by the requestor. Ferber et al also fail to explicitly disclose that the requested transaction is for admission to an event. Examiner takes official notice, however, that coupons were frequently used for admissions to certain events at the time of applicant's invention and it would have been obvious to one of ordinary skill in the art at the time of applicant's invention that the coupon disclosed by Ferber et al may have been used for access to any type of product or service, including admission to an event.

This is a provisional obviousness-type double patenting rejection.

Conclusion

12. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention.

13. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ramachandran [6,315,195] discloses a transaction apparatus and teach displaying a bar code on a wireless communication device used to facilitate the processing of a transaction.

Art Unit: 3621

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

Commissioner of Patents and Trademarks

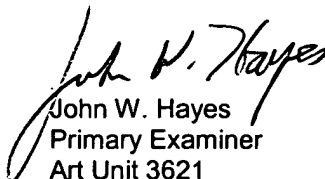
Washington, D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including
After Final communications labeled
"Box AF"]

(703) 746-5531 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.


John W. Hayes
Primary Examiner
Art Unit 3621

November 22, 2004